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**THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

REPLY BRIEF FOR APPELLANT

Masayuki HATANAKA

Serial No.: 10/069,113

Filed: June 24, 2002

Title: RECORDING DEVICE

Appeal No.: Unassigned

Group Art Unit: 2131

Examiner: Taghi T. Arani

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Date: January 5, 2007



**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Appeal No: **Unassigned**

In re the Application of: **Masayuki HATANAKA**

Confirmation No.: **3459**

Serial Number: **10/069,113**

Group Art Unit: **2131**

Filed: **June 24, 2002**

Examiner: **Taghi T. Arani**

For: **RECORDING DEVICE**

Atty. Docket No.: **020233**

Customer No.: **38834**

REPLY BRIEF

Mail Stop: Appeal Brief – Patents

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

January 5, 2007

In response to the Examiner's Answer mailed November 7, 2006, Appellant submits the following Reply Brief.

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I. STATUS OF CLAIMS

Claims 1-5 and 13-18 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Hasebe* (U.S. Patent No. 5,392,351) in view of *Lang* (U.S. Patent No. 5,191,611); and claims 6-12 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Hasebe* in view of *Lang* and further in view of *Shear* (U.S. Patent Application Publication No. 2001/042043).

Claims 1-18 are the subject of this appeal.

II. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The grounds of rejection to be reviewed on appeal are whether claims 1-5 and 13-18 are unpatentable over *Hasebe* in view of *Lang* under 35 U.S.C. § 103(a); and whether claims 6-12 are unpatentable over *Hasebe* in view of *Lang* and further in view of *Shear* under 35 U.S.C. §103(a).

III. ARGUMENT

A. User Information Hold Unit

In the Appeal Brief, Appellant argued that *Hasebe* in view of *Lang* does not teach or suggest “a user information hold unit holding first user ID data provided to identify a user of said recording device” as recited in claim 1.

In the Examiner’s Answer, the Examiner takes the position that personal number 91 in *Hasebe*, which identifies the user’s computer, is associated with both the user and the computer. (Examiner’s Answer, page 10.)

Appellant submits that personal number 91 is not user information for identifying a user. Personal number 91 is unique to a computer and is used by a software vendor to limit use of a software storage medium to the computer from which the personal number originated. (Col. 3, lines 60-66.)

Moreover, even if personal number 91 is associated with both the user and the computer, as alleged by the Examiner, the personal number is not used to identify a user of the user computer. *Hasebe* discloses that the personal number is used for creating a personal key. The personal key encrypts the software decrypting key on the vendor computer and decrypts the software decrypting key on the user computer. (Col. 3, lines 40-56; Fig. 1.) The personal number is not used by the user computer to identify the user of the user computer.

Therefore, *Hasebe* in view of *Lang* does not disclose “a user information hold unit holding first user ID data provided to identify a user of said recording device” as recited in claim 1.

B. Control Unit

In the Appeal Brief, Appellant argued that *Hasebe* in view of *Lang* does not teach or suggest “a control unit controlling an operation of said recording device, said control unit referring to said protection information to restrict access to said encrypted content data held in said first storage unit” as recited in claim 1.

In the Examiner’s Answer, the Examiner takes the position that Appellant relied on features which are not recited in the rejected claims. (Examiner’s Answer, page 11.) Specifically, the Examiner states that Appellant relied on “a reproduction flag, which is referred to before proceeding to decryption of the encrypted data,” for traversing the rejection.

The decrypting circuit 93 of *Hasebe* decrypts permission information 72 using the personal key generated by the personal key generating unit. The decrypting circuit does not refer to information for restricting access to the encrypted permission information. In other words, the decrypting circuit does not determine whether certain conditions are met before decryption proceeds. The decryption circuit attempts decryption without referring to protection information for restricting access. If the personal key is incorrect then the decryption attempted by the decryption circuit fails. The decryption circuit does not refer to protection information before attempting to decrypt the data.

The Examiner did not respond to our argument that decrypting circuit 93 attempts decryption without referring to protection information that may restrict access. The Examiner only states that Appellant relied on features which are not recited in the rejected claims. However, claim 1 recites (emphasis added):

a control unit controlling the operation of said recording device, *said control unit referring to said protection information to restrict external access* to said encrypted content data held in said first storage unit.

Appellant's argument is that *Hasebe* does not disclose a control unit that refers to protection information for restricting external access. This argument relies directly on the language of the claim.

In *Hasebe*, decrypting circuit 93 attempts decryption without referring to protection information for restricting access. Therefore, *Hasebe* does not disclose "a control unit controlling the operation of said recording device, said control unit referring to said protection information to restrict external access to said encrypted content data held in said first storage unit" as recited in claim 1.

C. Protection Information Memory Unit

In the Appeal Brief, Appellant argued that *Hasebe* in view of *Lang* does not teach or suggest "a protection information memory unit holding protection information updatable in response to a result of comparing externally provided user information with said first user ID data, as externally instructed" as recited in claim 1.

In the Examiner's Answer, the Examiner takes the position that Appellant relied on features which are not recited in the claims. (Examiner's Answer, page 11.) Specifically, the Examiner states that Appellant relied on detailed features of "protection information" which are not recited in the claims. The Examiner also states that Appellant relied on the following feature which is not recited in the claims: "protection information is updatable in response to a result of comparing externally provided user information with the first user ID data, as externally provided." (Examiner's Answer, pages 11-12.)

Appellant submits that protection information as recited in claim 1 is used “to restrict external access to said encrypted content data.” (Claim 1.)

The Examiner takes the position that permission information 13 of *Hasebe* is protection information. (Examiner’s Answer, page 4, citing *Hasebe*, col. 5, lines 40-45.) However, permission information 13 in *Hasebe* is the encrypted data decrypting key. “[P]ermission information 13 incorporates encrypted data for decrypting the encrypted software.” (Col. 5, lines 41-44.) Permission information 13 is generated by the vendor computer by encrypting the software decrypting key. (Col. 5, lines 40-45; Figs. 1-3.) Thus, permission information 13 provides access to the encrypted software. Permission information 13 does not “restrict external access to said encrypted content data” as recited in claim 1.

Appellant also submits that claim 1 recites that the protection information memory unit holds protection information that is “updatable in response to a result of comparing externally provided user information with said first user ID data, as externally instructed.” (Claim 1.)

The Examiner cited *Lang* for disclosing this feature. (Examiner’s Answer, page 4, citing *Lang*, col. 12, lines 36-58.) *Lang* at col. 12, lines 36-58, states a procedure for an information provider to limit and control user privileges to information. The procedure first states that users authorized by the information provider are given a specific number of information retrievals. Once the specific number of retrievals has been reached, the user must renew or update privileges to information. To renew user privileges, the user must request renewal. Then the information provider gives the user an updated access code.

In *Lang*, the number of allowed retrievals of protected information is renewable or updatable in response to an “information provider” giving the user an updated access code. In the present claimed invention, protection information is “updatable in response to a result of comparing externally provided user information with said first user ID data, as externally instructed.” (Claim 1.) In other words, in the present claimed invention, a user that corresponds to the first user ID data on the recording device can update the protection of information on the recording device.

Therefore, *Hasebe* in view of *Lang*, does not teach or suggest features specifically recited in claim 1. Specifically, *Hasebe* in view of *Lang*, does not teach or suggest “protection information” used “to restrict external access to said encrypted content data” and “a protection information memory unit” which holds protection information that is “updatable in response to a result of comparing externally provided user information with said first user ID data, as externally instructed.”

D. Detachably Attachable Recording Device

In the Appeal Brief, Appellant argued that *Hasebe* in view of *Lang* does not teach or suggest “a recording device detachably attachable to a reproduction apparatus” as recited in claim 1.

In the Examiner’s Answer, the Examiner takes the position that this recitation does not have patentable weight because the recitation occurs in the preamble. (Examiner’s Answer, page 12.)

Appellant submits that the recitation, “a recording device detachably attachable to a reproduction apparatus” as recited in claim 1, should be given patentable weight. “Any terminology in the preamble that limits the structure of the claimed apparatus must be treated as a claim limitation.” MPEP 2111.02(I), citing *Corning Glass Works v. Sumitomo Elec. U.S.A., Inc.*, 868 F.2d 1251, 1257 (Fed. Cir. 1989).

The limitation “a recording device detachably attachable to a reproduction apparatus” recited in the preamble, recites structure of the claimed apparatus. The recording device has a structure such that it is detachably attachable to a reproduction apparatus. Since the limitation recites structure of the claimed apparatus, the limitation should be given patentable weight.

Hasebe does not disclose a circuit having the elements recited in claim 1 in a detachably attachable storage media. The personal key generating unit 92 and the decrypting circuit 93 are cited by the Examiner as the “user information hold unit” and the “control unit,” respectively. (Examiner’s Answer, pages 3-4.) *Hasebe* discloses that personal number 91, personal key generating unit 92 and decrypting circuit 93 are included in the user computer as opposed to the software storage medium 71. (Col. 3, lines 14-26.) In addition, the Examiner cites *Hasebe* at col. 3, lines 54-56 for disclosing the “data input/output unit” and the “first storage unit.” *Hasebe* at col. 3, lines 54-56 discusses the main storage of the user computer, not the detachably attachable storage medium.

The recitation, “a recording device detachably attachable to a reproduction apparatus” as recited in claim 1, should be given patentable weight. *Hasebe* does not disclose this feature recited in claim 1. Thus, *Hasebe* in view of *Lang* does not disclose the elements as recited in claim 1.

Reply Brief
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In the event this paper is not timely filed, Appellant petitions for an appropriate extension of time. The fee for any such extension may be charged to our Deposit Account No. 50-2866, along with any other additional fees which may be required with respect to this paper.

Respectfully submitted,

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